

RECEIVED
CENTRAL FAX CENTER

JUN 27 2006

OFFICIAL

CARDINAL LAW GROUP

1603 Orrington Avenue/Suite 2000
Evanston, Illinois 60201
Telephone 847 - 905 - 7111
Facsimile 847 - 905 - 7113

Date: JUNE 27, 2006

To: EXAMINER DENNIS G. BONSHOCK
U.S. PATENT AND TRADEMARK OFFICE

Fax #: (571) 273-8300

From: FRANK C. NICHOLAS
Phone #: (847) 424.2521

Client/Matter No.: AUS920010923US1 (9000/81)

of Pages: 8

(including cover sheet)

IF YOU HAVE ANY PROBLEMS RECEIVING THIS MESSAGE, PLEASE CALL 847/905-7111, Ext. 112 AND ASK FOR JENNIFER CRUZ.

THIS MESSAGE IS INTENDED ONLY FOR THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED. IT MAY CONTAIN PRIVILEGED, CONFIDENTIAL, ATTORNEY WORK PRODUCT, OR TRADE SECRET INFORMATION WHICH IS EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAWS. IF YOU ARE NOT THE INTENDED RECIPIENT, OR AN EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE (AND ALL COPIES) TO US BY MAIL AT THE ABOVE ADDRESS. WE WILL REIMBURSE YOU FOR POSTAGE.

JUN 27 2006

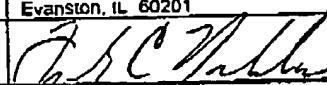
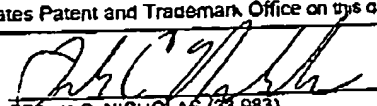
PTO/SB/1 (12-07), Approved for use through 1/31/08. OMB 0321-0031. Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE
Under the Paper Reduction Act of 1996, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h1>TRANSMITTAL FORM</h1> <p>(to be used for all correspondence after initial filing)</p>	Attorney Docket No.	AUS920010923US1 (8000/81)
	Application Number	09/981,877
	Filing Date	OCTOBER 18, 2001
	First Named Inventor	ANTHONY E. MARTINEZ
	Group Art Unit	2173
	Examiner	BONSHOCK, DENNIS G

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Amendment	<input type="checkbox"/> Assignment Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Drawings:	<input checked="" type="checkbox"/> Reply Brief
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> After Allowance Communication to Group	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Post Card Receipt
<input type="checkbox"/> Petition for Extension of Time Request (dup)	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Additional Enclosure(s) (please identify below)
<input type="checkbox"/> Express Abandonment Under 37 CFR 1.138	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/>
<input type="checkbox"/> Supplemental Information Disclosure Statement, PTO-1449, art	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/>
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Small Entity Statement	<input type="checkbox"/>
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Request of Refund	<input type="checkbox"/>
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed.		
<input checked="" type="checkbox"/> I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed.		

CALCULATION OF FEE

	Claims After Amendment	Highest No. Previously Paid For	Present Extra	Small Entry		or	Large Entry	
				Rate	Add'l Fee		Rate	Add'l Fee
Total	Minus		0	x \$25=	0		x \$50=	
Indep.	Minus		0	x \$100=	0		x \$200=	
First Presentation of Multiple Dep. Claim				+ \$180=	-		+ \$380=	
				total add'l fee	\$ 0		total add'l fee	\$ 0

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual name	FRANK C. NICHOLAS Registration No. 33,983 CARDINAL LAW GROUP 1603 Ormington Avenue, Suite 2000 Evanston, IL 60201		
Signature		Date	June 27, 2006
CERTIFICATE OF FACSIMILE			
I hereby certify that this correspondence is being transmitted by facsimile to (571) 273-8300 to the United States Patent and Trademark Office on this date:			June 27, 2006
Signature		Date:	June 27, 2006
FRANK C. NICHOLAS (33,983)			

JUN 27 2006

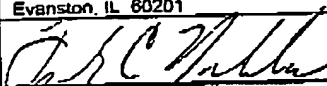
FOR BEST RESULTS, APPLICANTS SHOULD FILE THROUGH USPO. ONE DESKTOP Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paper Reduction Act of 2002, no postage is required to respond to a solicitation of information unless it specifically states otherwise.

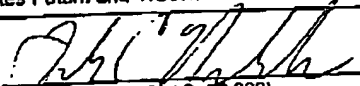
<h1>TRANSMITTAL FORM</h1> <p><i>(to be used for all correspondence under initial filing)</i></p>	Attorney Docket No	AUS920010923US1 (9000/81)
	Application Number	09/981,877
	Filing Date	OCTOBER 18, 2001
	First Named Inventor	ANTHONY E. MARTINEZ
	Group Art Unit	2173
	Examiner	BONSHOCK, DENNIS G

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Amendment	<input type="checkbox"/> Assignment Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Drawings:	<input checked="" type="checkbox"/> Reply Brief
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> After Allowance Communication to Group	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter	<input type="checkbox"/> Petition Rounding Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Post Card Receipt
<input type="checkbox"/> Petition for Extension of Time Request (dup)	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Additional Enclosure(s) (please identify below)
<input type="checkbox"/> Express Abandonment Under 37 CFR 1.138	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/>
<input type="checkbox"/> Supplemental Information Disclosure Statement, PTO-1449, art	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/>
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Small Entity Statement	<input type="checkbox"/>
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Request of Refund	<input type="checkbox"/>
<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed.		
<input checked="" type="checkbox"/> I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed.		

CALCULATION OF FEE

				Small Entity		Large Entity	
	Claims After Amendment		Highest No. Previously Paid For	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus		x \$25=	0	x \$50=	
Incep.		Minus		x \$100=	0	x \$200=	
First Presentation of Multiple Dep. Claim				+ \$180=	--	+ \$360=	
				total add'l fee	\$ 0	total add'l fee	\$ 0

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or individual name	FRANK C. NICHOLAS Registration No. 33,983 CARDINAL LAW GROUP 1803 Orrington Avenue, Suite 2000 Evanston, IL 60201
Signature	 Date: June 27, 2006

CERTIFICATE OF FACSIMILE	
I hereby certify that this correspondence is being transmitted by facsimile to (571) 273-8300 to the United States Patent and Trademark Office on this date: June 27, 2006	
Signature	 Date: June 27, 2006
FRANK C. NICHOLAS (33,983)	

RECEIVED
CENTRAL FAX CENTER

JUN 27 2006

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted
via facsimile to (571) 273-8300 to the United States
Patent and Trademark Office on June 27, 2006

(Date of Transmission)

FRANK C. NICHOLAS (33,983)

Name of applicant, assignee or registered representative

Frank C. Nicholas

Signature

June 27, 2006

Date of Signature

PATENT
Case No. AUS920010923US1
(9000/81)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:)
)
 ANTHONY E. MARTINEZ, ET AL.)
)
 Serial No.: 09/981,877)
)
 Filed: OCTOBER 18, 2001)
)
 Title: METHOD OF PREVIEWING A)
 GRAPHICAL IMAGE CORRESPONDING)
 TO AN ICON IN A CLIPBOARD)

Examiner: BONSHOCK, DENNIS G.

Group Art Unit: 2173

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Reply Brief as follows:

June 27, 2006
Case No.: AUS920010923US1 (9000/81)
Serial No.: 09/981,877
Filed: October 18, 2001
Page 2 of 5

The Examiner fails to introduce any new support for his §102(a) rejection in his answer brief. Appellants maintain that the "MSWord" reference is not a §102(a) reference, and that "MSWord" does not disclose each element of the claims.

Claim 1 requires, *inter alia*, "displaying the graphical image associated with the icon in response to the icon preview instruction." Thus, a graphical image associated with the icon is displayed in response to an icon preview instruction. Three elements are present in this section of the claim: 1) an icon preview instruction, 2) an icon, and 3) a graphical image associated with the icon. In order to anticipate the claim, "MSWord" must disclose each element.

An "icon" is a picture on a screen that represents a specific file, directory, window, option, or program, according to an exemplary definition from *The American Heritage® Dictionary of the English Language, Fourth Edition*. In contrast, "text" is, according to the same source, "the original words of something written or printed, as opposed to a paraphrase, translation, revision, or condensation."

At most, the "reference" discloses that a *text* sample of the clipboard icon is disclosed upon a mouse action, and not the display of a *graphical* image associated with the icon. See, MS Figure 2. The Examiner's attempt to argue that text and graphics are identical is flawed.

June 27, 2006
Case No.: AUS920010923US1 (9000/81)
Serial No.: 09/981,877
Filed: October 18, 2001
Page 3 of 5

A box surrounding the graphical image of text is not associative of an icon, in contrast to the Examiner's arguments. See, p.6 of the Examiner's answer. A box is not associative of a "W."

Regardless of the merits of Appellants argument above, however, there can be no proper rejection of the claims based on "MSWord." While the Examiner correctly identifies the strictures of §102(a), the Examiner's statement that a copyright date "alone proves that the MSWord reference was known and used prior to the filing of the applicants claimed invention" illustrates a fundamental misconception of patent law.

The law is clear that a document only qualifies as a reference under 35 U.S.C. §102(a) "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that person interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." See MPEP 2128, *In re Wyer*, 655 F.2d 221 (CCPA 1981).

In contrast, 17 U.S.C. §102 states that "copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." Thus, the fact that a document claims copyright *does not mean* that the document has been disseminated or otherwise made available. Furthermore, that a document claims copyright to a date more than one year prior to the instant filing date does not mean that a particular portion of the document was included in the copyrighted work at the time that the copyright notice was

June 27, 2006
Case No.: AUS920010923US1 (9000/81)
Serial No.: 09/981,877
Filed: October 18, 2001
Page 4 of 5

affixed. For example, the Examiner indicates that the copyright notice claims copyright "1983-1999" but does not allege that the document was the same document during that time period, and does not allege that after 1999, the document ("MSWord") is the same document that was subject to a copyright claim in 1999.

The "MSWord" reference was generated by the Examiner more than 2.5 years after the instant filing, and this reference cannot support this rejection.

Allowance of claim 1, and all claims depending therefrom is requested.

June 27, 2006
Case No.: AUS920010923US1 (9000/81)
Serial No.: 09/981,877
Filed: October 18, 2001
Page 5 of 5

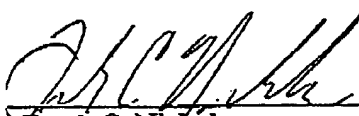
CONCLUSION

The Appellants respectfully submit that claims 1-16 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: June 27, 2006

Respectfully submitted,
ANTHONY E. MARTINEZ, *et al.*

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



Frank C. Nicholas
Registration No. 33,983
Attorney for Appellants

Jennifer Cruz

From: Paul Hietko
Sent: Friday, June 23, 2006 12:04 PM
To: Jennifer Cruz
Cc: Debra Molinari
Subject: 9000/81

Please refile the Reply Brief previously filed.

Please file on or before July 6, 2006. File on my desk.

Paul M. Hietko
Patent Attorney
Cardinal Law Group
1603 Orrington Suite 2000
Evanston, IL 60201
(847) 905 - 7111
fax (847) 905 - 7113

The information contained in this email message is intended only for use of the individual or entity named above. If the reader of this message is not the intended recipient, or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by United States telephone (847-905-7111), and destroy the original message. Thank you.